# In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 869

HOMER G. THOMSON, PETITIONER

*v.*

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS*

## BRIEF FOR THE RESPONDENT IN OPPOSITION

### OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. A–22) is reported at 336 F. 2d 604.

### JURISDICTION

The original judgment of the Court of Customs and Patent Appeals was entered on April 25, 1963. A petition for rehearing was granted on June 28, 1963. On September 24, 1964, the court's judgment on rehearing was entered. A second petition for rehearing was denied on November 5, 1964. The petition for a writ of certiorari was filed on February 1, 1965. The jurisdiction of this Court in invoked under 28 U.S.C. 1256.



768-549—65

### QUESTION PRESENTED

Whether, in upholding the Patent Office's rejection of some of petitioner's patent claims, the Court of Customs and Patent Appeals impermissibly considered evidence which had not been produced before the Patent Office.

### STATUTE INVOLVED

35 U.S.C. 144 provides:

> ***Decision on appeal.***
>
> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

### STATEMENT

On March 12, 1958, petitioner applied to the Patent Office for a patent on a "Composition Resistor With Embedded Terminal Lead Head." The proposed invention involved a molded composition electrical resistor of fixed resistance consisting of an elongated cylindrical body of insulating material surrounding and bonded to a high resistance conductor. The resistor was of the type customarily used as a basic component in popular electronic circuits such as those employed in radio and television equipment. Affixed at each end of the cylindrical body was a terminal electrode consisting of a lead wire with an enlarged head embedded in the high resistance conductor.

Petitioner based his right to a patent on the configuration of the enlarged head. Instead of utilizing a "frusto-conical" head like those in earlier patents which were referred to in the petitioner's submission, a "dumbbell" shaped head was employed. Relying upon two prior art references (Bradley, No. 1,835,267, and Steenweg, No. 1,976,901), the Patent Office examiner rejected a majority of petitioner's claims, and allowed only two. On appeal to the Board of Appeals of the Patent Office, the Board considered as "background art," along with the references disclosed in the application, three other earlier patents (Megow, No. 2,271,774; Kohring, No. 2,597,338; and Patla, No. 2,698,372). The board agreed that the improvement upon which petitioner predicated his right to a patent—the changed terminal head configuration—was fully taught by the Steenweg patent.

Petitioner appealed this decision to the Court of Customs and Patent Appeals. A majority of that court agreed with the decision of the Board, stating (Pet. A–13):

> In view of [petitioner's specification], as well as our evaluation of the three Megow patents, it is clear that the sole difference between the claimed resistors and the prior art lies in the particular shape and structure of the terminal head on the lead wires. The immediate question, therefore, becomes whether a terminal head such as claimed by appellant is disclosed in the prior art, and if so, whether its use in a resistor such as claimed is suggested by the prior art. We think both questions must be answered affirmatively.

The court's initial decision was based partly on the fact that one of the three Megow patents in the record –the one relied upon by the Board as "background art"—exhibited a terminal head which had a small depression around it making it "quite similar to the dumbbell shape" (Pet. A–14). The court also rested its decision on a finding that dumbbell shaped metal terminal members were "conventional in the art" (Pet. A–14) and that their use on the type of resistor involved in petitioner's application was an obvious choice to a person skilled in the art.

Petitioner objected on rehearing to the court's reliance on the shape of the terminal head in the third Megow patent. The court then issued an amended opinion omitting any mention of that factor and stating (Pet. A–29):

> In his petition for rehearing and his brief on rehearing, appellant argues that reference in the original opinion to the Megow drawings as showing a small concave depression extending around the head is improper because that construction of the Megow patents was not previously raised or discussed. Assuming, without deciding, that appellant is correct in that contention, the matter is moot since it should be clear that we have given no consideration to that aspect in concluding that the appealed claims are unpatentable.

## ARGUMENT

There is no merit whatever to petitioner's claims that the procedure followed in this case by the Court of Customs and Patent Appeals violated constitutional or statutory provisions. The issue before that

court—like the issue before the Patent Office examiner and Board of Appeals—was whether petitioner's application disclosed a patentable invention over prior art. In passing upon this question, the Court of Customs and Patent Appeals was limited, by statute, to "the evidence produced before the Patent Office" (p. 2, *supra*). That evidence included all the prior art references relied upon by the examiner and the Board of Appeals. The court examined those references and determined, as a result of its examination, that the proposed invention was merely "an obvious choice * * * to one skilled in the art" (Pet. A–28) and was, therefore, unpatentable under 35 U.S.C. 103.

Neither the fact that the court relied on patents other than those considered dispositive by the Board of Appeals nor the fact that it articulated its reasons for rejecting petitioner's claims differently than did the Patent Office invalidates its judgment. The additional prior patents were in the Patent Office record, and reliance upon them was permissible under 35 U.S.C. 144. The court was not, as petitioner contends, performing the "examination function assigned by Congress to the Commissioner of Patents" (Pet. 13) when it merely reviewed the prior art in the record and exercised its own judgment as to its effect on petitioner's claims. It did not, as could the Patent Office, seek out the prior art references by which the patentability of petitioner's invention was to be judged, but performed only its statutory function of passing upon the record made before the Patent Office.

Nor is there any substance to the claim that the court impermissibly supported its judgment with

reasons different from those supplied by the Patent Office. Both the Patent Office and the court relied substantially on the same series of prior inventions which rendered petitioner's improvement obvious. To the extent that there was any difference between the articulated grounds of decision, the Court of Customs and Patent Appeals merely particularized the aspects of the prior patents which had anticipated petitioner's invention.

## CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

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MARCH 1965.

U.S. GOVERNMENT PRINTING OFFICE : 1965